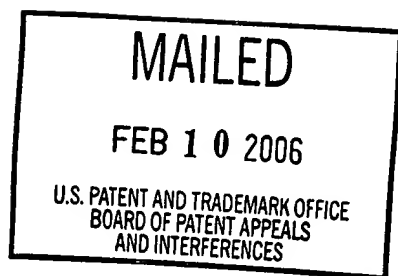


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte GREGORY MAURICE PLOW
and
FARROKH E. POURMIRZAIE



Appeal No. 2006-0014
Application No. 09/922,182

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

REMAND

The above-identified application is being remanded to the examiner for appropriate action.

BACKGROUND

1. Claims 1 to 4, 6 to 11 and 13 to 19 are pending and were finally rejected in the Office action mailed December 23, 2004.

2. A Notice of Appeal and an Appeal Brief were filed on February 11, 2005. The status of claims section of the Appeal Brief includes a statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) but does not include an identification of those claims that are being appealed as required by 37 CFR § 41.37(c)(1)(iii). The summary of the claimed subject matter section of the Appeal Brief includes a concise explanation of the subject matter defined in each of the independent claims involved in the appeal but does not include for independent claim 14 an identification of every means plus function limitation and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters as required by 37 CFR § 41.37(c)(1)(v). In addition, the argument section of the Appeal Brief does not treat each ground of rejection under a separate heading as required by 37 CFR § 41.37(c)(1)(vii). The argument section of the Appeal Brief sets forth why the Kim publication (US 2002/0052925 A1) is not prior art to the claims under appeal.

3. An Examiner's Answer was mailed on June 13, 2005. In the answer, the examiner sets forth in a chart (pp. 7-9) why the Kim publication is prior art to the claims under appeal.

4. A Reply Brief was filed on July 1, 2005. In the Reply Brief, the appellants argue (pp. 1-4) for the first time why the chart set forth in the answer is insufficient to establish the Kim publication as prior art to the claims under appeal.

5. On July 13, 2005 an Office communication was mailed noting that the reply brief had been entered and considered and that the application had been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal. In this communication, the examiner did not respond to the arguments raised for the first time in the Reply Brief.

ACTION

The burden of establishing a prima facie case of anticipation resides with the examiner. See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Likewise, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). As such, it is the examiner's burden to establish that Kim is available as prior art under 35 U.S.C. § 102(e)¹ with respect to the claims under appeal.

¹ 35 U.S.C. § 102(e) provides that a person shall be entitled to a patent unless the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.

In view of the burden to establish that Kim is available as prior art under 35 U.S.C. § 102(e) resting with the examiner, we remand this application to the examiner to respond to the arguments raised in the Reply Brief that Kim is not prior art under 35 U.S.C. § 102(e).

In addition, since the Appeal Brief does not comply with all the requirements of 37 CFR § 41.37(c) as set forth above, we remand this application to the examiner to notify the appellants of the non-compliance and give the appellants a time period within which to file an amended brief as provided by 37 CFR § 41.37(d).

CONCLUSION

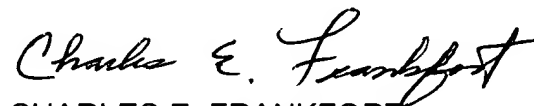
This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

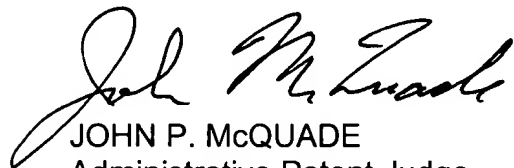
If after action by the examiner in response to this remand there still remains decision(s) of the examiner being appealed, the application should be promptly returned to the Board of Patent Appeals and Interferences.

We hereby remand this application to the examiner for action as required by this remand, and for such further action as may be appropriate.

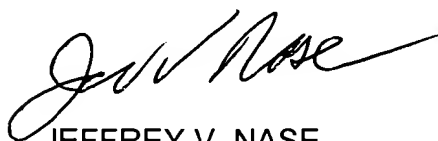
REMANDED



CHARLES E. FRANKFORT
Administrative Patent Judge



JOHN P. McQUADE
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge

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Appeal No. 2006-0014
Application No. 09/922,182

Page 6

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